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SHEPPARD, MULLIN, RICHTER & HAMPTON LLP			EXAMINER	
333 SOUTH HOPE STREET			JACKSON, DANIELLE	
48TH FLOOR				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/588,249

**Applicant(s)**

LENAHAN, DAVID G.

**Examiner**

DANIELLE JACKSON

**Art Unit**

3636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10/23/09.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-7,9-21,23-26,28 and 29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-21,23-26,28 and 29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2009 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "650" and "425" have both been used to designate the same support rib. Reference characters "445" and "615" have both been used to designate the same support rib. Reference characters "200" and "671" have both been used to designate the apex point. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. Furthermore, any changes made to the drawings must be reflected in the specification.

### ***Specification***

The disclosure is objected to because of the following informalities: Reference character "415" has been referred to by a variety of different names, such as "visor length extension 415", "visor extension 415", "visor portion 415", and "visor extension

portion 415", all used interchangeably . The names given to the same part should be CONSISTENT throughout the entire application to avoid confusion.

Appropriate correction is required.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: On lines 11-12, "the main support members" should be changed to --the main support member—since only one main support member has previously been recited. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-7 and 9-21, 23-26, 28 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites "a convex leading edge". The leading edge being convex is not supported by the specification. This limitation is NEW MATTER.

Claims 13 and 29 recite "an alignment gauge comprising a light transmitting material extending through the cover". The alignment gauge is mentioned in the specification, but not described in a manner that is clear and easy to comprehend. One of ordinary skill would not know how the alignment gauge functions given the description in the disclosure nor would one understand how to make such an "alignment gauge". Is the entire alignment gauge made of light transmitting material? How does the alignment gauge operate? Is sun reflected through the alignment gauge when the angle of the tilt of the canopy needs to be adjusted? Does sun actually shine down on a portion that is normally in the coverage area? What is its purpose and why is it necessary to the canopy?

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-7, 13-21, 23-26, 28 and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 3 and 17 recite "one or more traversal support members". It is not clear what is meant by the traversal support members. Are those the same as the unequal extensions or the adjacent support members? For examination purposes, they are assumed to be the same as the unequal extensions.

Claim 13 recites "an unequal extensions". It is not clear if there is only one extension of a plurality of extensions.

Claims 18 and 21 recite "the one or more traversal support members". It is not clear what is meant by the traversal support members. Are those the same as the unequal extensions or the adjacent support members? Furthermore, said limitation lacks antecedent basis in the claim. For examination purposes, they are assumed to be the same as the unequal extensions.

Claims 19 and 20 recite "the one or more support members". It is not clear what is meant by the traversal support members. Are those the same as the unequal extensions or the adjacent support members? Furthermore, said limitation lacks antecedent basis in the claim. For examination purposes, they are assumed to be the same as the unequal extensions.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-7, 9-12, 14, 17-21, 23-26 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Earnshaw et al. (US-5,086,797) in view of Kida (US-4,474,201).

Earnshaw et al. discloses a canopy for a stationary covering device comprising: a covering having asymmetrical positioned vertex point (3) from which the cover projects with unequal extension (not shown, but taught in column 4, lines 43-59), the canopy

being rotatable around a fixed longitudinal axis, vertical support (4, 5) located beneath the canopy which can be tilted (see FIGS. 2-3), relative to the ground to provide an adjustable coverage zone within a desired stationary area when rotated from a first canopy position to a second canopy position at an elevation level relative to the ground. Furthermore, Earnshaw et al. discloses a one or more traversal support members, or support ribs (7).

Earnshaw et al. is silent on the specifics of the canopy, such as the leading edge and the material used to make the canopy, as well as the means by which the canopy be made asymmetrical. Kida discloses an umbrella comprising: a single pliable cloth cover (35) having an asymmetrical positioned vertex point (2) from which the cover projects with unequal extensions (FIG. 4). Kida teaches support ribs that traverse the cover, wherein some of the support ribs have a fixed length (3) and some of the support ribs have a variable length (18) where they are adjusted by an extendible member (FIG. 1(a)) to create a visor extension (such as that seen in FIG. 4) Kida further discloses the visor extension to be supported by a main support member and a plurality of adjacent support members (in FIG. 4, there are three extendible ribs members and the middle one is the main support member and the two other ribs are adjacent support members). It appears the main support member creates an apex of the convex leading edge, however it would be obvious to make the length of the adjacent support members shorter than the main support member to provide a smooth curved edge for aesthetic appeal. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Earnshaw et al. to include extendable support members

that support a canopy made of pliable cloth, as suggested by Kida, so that the shape and size of the canopy could be changed to various configurations in an easy convenient manner, therefore eliminating the need to obtain a whole new-shaped canopy.

Regarding claims 11 and 25, both Earnshaw et al. and Kida are discussed above but are silent on the asymmetry ratio of the unequal extensions, however it would have been obvious to one of ordinary skill in the art to modify Earnshaw et al. to provide a canopy with a ratio in a range between 1.5:1 and 2.3:1 measured horizontally in plan view. Every asymmetrical umbrella has a ratio of extended ribs to fixed ribs and the particular ratio would have been an obvious matter of design choice within the skill of the art because the particular ratio presents no novel or unexpected result.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Earnshaw et al. (US-5,086,797) in view of Kida (US-4,474,201) as applied to claim 12 above, and further in view of Ma (US-2002/0129847 A1).

The combination of Earnshaw et al. and Kida is discussed above but lacks the support mechanism comprising a cantilevered support at the vertex point by a projection from above the canopy. Ma shows a canopy having a canopy (15) that is supported by a projection (16) located above the canopy that is attached to a cantilevered support (12). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Earnshaw et al. and Kida to include a cantilevered support mechanism that attaches to a point above the canopy, as



suggested by Ma, so there will not be an undesired support mechanism under the canopy.

Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Earnshaw et al. (US-5,086,797) in view of Kida (US-4,474,201) as applied to claim 28 above, and further in view of Wispelere (US-2,841,1600).

The combination of Earnshaw et al. and Kida is discussed above but lacks an alignment gauge. Wispelere teaches an umbrella having canopy (14) having an alignment gauge (21) comprising a light transmitting material (transparent; column 2, lines 37-39) extending through the cover (if sun is shining directly through 21, the user may tilt the umbrella so it is not in their eyes, usually flap 10 shields sunlight from entering the canopy from most angles). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Earnshaw et al. and Kida to include an alignment gauge so the user has means for realizing the optimal angle for sun protection.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Earnshaw et al. (US-5,086,797) in view of Freedman (US-2004/0134526 A1).

Earnshaw et al. discloses a canopy for a stationary covering device comprising: a covering having asymmetrical positioned vertex point (3) from which the cover projects with unequal extension (not shown, but taught in column 4, lines 43-59), the canopy being rotatable around a fixed longitudinal axis, vertical support (4, 5) which can be

tilted (see FIGS. 2-3), relative to the ground to provide an adjustable coverage zone within a desired stationary area when rotated from a first canopy position to a second canopy position at an elevation level relative to the ground; and a fixed support mechanism (1) for positioning the canopy relative to the elevated level.

Earnshaw et al. lacks an alignment gauge. Wispelere teaches an umbrella having canopy (14) having an alignment gauge (21) comprising a light transmitting material (transparent; column 2, lines 37-39) extending through the cover (if sun is shining directly through 21, the user may tilt the umbrella so it is not in their eyes, usually flap 10 shields sunlight from entering the canopy from most angles). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Earnshaw et al. and Kida to include an alignment gauge so the user has means for realizing the optimal angle for sun protection.

### ***Response to Arguments***

Applicant's arguments filed 10/23/09 have been fully considered but they are not persuasive. Applicant argues that "Earnshaw in view of Kida fails to teach or suggest a main support member having a length less than a plurality of adjacent support members". The Examiner maintains that in Kida it appears the main support member creates an apex of the convex leading edge, however it would be obvious to make the length of the adjacent support members shorter than the main support member to provide a smooth curved edge for aesthetic appeal as discussed in the rejection above.

Applicant's arguments with respect to claims 13 and 29 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **DANIELLE JACKSON** whose telephone number is (571)272-2268. The examiner can normally be reached on Monday through Friday 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Dunn can be reached on (571) 272-6670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DAVID DUNN/  
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